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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,089	01/25/2002	Frank G. Liedl JR.	F1103/1(V)	3328
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Norris, McLaughlin & Marcus P.O. Box 1018 Somerville, NJ 08876-1018				
EXAMINER PRATT, HELEN F				
ART UNIT		PAPER NUMBER		
1761				

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/057,089

Applicant(s)

LIEDL ET AL.

Examiner

Helen F. Pratt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10, 12, 19 of U.S. Patent No. 6,136,366. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are to a product with the same ingredients, and particle sizes and nothing is seen that the spreadability of the would not have been as claimed.

***Claim Rejections - 35 USC § 112***

Claims 1-6 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. No basis is seen in the specification for the limitation of "at least 50% of the particles are

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smaller than about 3 microns". The specification requires on page 5 (0021) that "at least 50% of the particles are smaller than about 10 um".

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 6, 7 and 12 are indefinite in the use of the phrase "a spreadability of about 4.000 kg" or 4.915 kg. It is not known what is meant by this phrase.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong et al. (5,693,357) in view of Wong et al. (5,079,027), Wong et al. (5,885,645), Fix et al. (5,714,193) and Mead (6,010,737).

Wong discloses a nut butter containing nut ingredients, seasonings, stabilizer, emulsifier and bulking agents with a particle size distribution of which 90% of the particles are less than 40 microns, and 50 % of the particles are smaller than about 10 microns (abstract and col. 20, lines 18-25). Claim 1 differs from the reference in the limitation that 50% of the particles are smaller than about 3 microns and that 1.4% of the particles are larger than 58.7 and in the particular spreadability. However, Wong et al. '027 disclose a composition in which 80% of the particles are between 2-11 microns.

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Wong et al. '645 disclose a process of milling nuts to various micron sizes (col. 2, lines 56-65). Fix et al. disclose a process of milling nuts to a mean size of 10.5 microns (col. 9, lines 60-70). Meade discloses a process of milling nuts to various particle sizes (col. 11 and 12). Nothing new is seen in a small amount of the particles being larger than 58.7 as in crunchy peanut butter. As it is known to mill nuts to various particle sizes which determines among other things, the nut butters spreadability (Wong et al. '645 col. 1, lines 64-70 and col. 2, lines 1-10), it would have been obvious given the teachings of the prior art to vary the nut particle size in order to achieve a particular spreadability and to choose particular nut particle sizes for this purpose.

Claim 2 requires particular viscosities. Meade discloses a viscosity of 6,000 to 50 centipoise, which encompasses the 6000 to 14000 cp of the claim (col. 10, lines 26-30). Therefore, it would have been obvious to make a product with the claimed viscosity.

Claim 3 further requires nuts, a nut slurry or defatted nuts and claim 4 nut oil and claim 5 the use of a peanut ingredients and claim 6 a particular spreadability. Ground peanuts can be used as in claims 1 and 5 (col. 3, lines 50-61), oil as in triglycerides (col. 5, lines 56-70). The particular spreadability has been shown because particle sizes of nuts have been disclosed as above. Also, it would have been within the skill of the ordinary worker to vary the particle size to achieve a particular nut size as it is known that the particle size affects the viscosity of the product, i. e. the spreadability. Col. 5, lines 5-19 discloses various poise and below 7,000 poise. No criticality is seen in the particular level at this time absent a showing that 4 kg has a different spreadability than

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below 7000, or the 2000 cp of Fix et al. or the other references cited. Therefore, it would have been obvious to make a nut butter using the claimed particle sizes and ingredients as shown by the combined references.

Claim 7 further requires that the composition is a reduced fat nut spread. Wong et al. '357 discloses a reduced fat peanut spread (col. 18, lines 60-70, and col. 19, lines 1-9). Therefore, it would have been obvious to make a reduced fat spread as shown by the combined references. The further limitations of claims 8-12 have been discussed above and are obvious for those reasons.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 703-308-1978. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on (703) 308-3959. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

Hp 12-20-03

H. Pratt  
HELEN PRATT  
PRIMARY EXAMINER